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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/766,779	01/22/2001	Paul Foster	21300.105004	8352
20786	7590	10/07/2005	EXAMINER	
KING & SPALDING LLP 191 PEACHTREE STREET, N.E. 45TH FLOOR ATLANTA, GA 30303-1763			PATEL, JAGDISH	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 10/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/766,779

Applicant(s)

FOSTER ET AL.

Examiner

JAGDISH PATEL

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/8/05</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This communication is in response to amendment filed 6/30/05.

#### ***Response to Amendment***

2. Claims 1-10 have been amended and new claim 28 has been added.

#### ***Response to Arguments***

3. Applicant's arguments with respect to claim 1-10 have been considered but are not persuasive. With regards to Hough reference, the applicant argues that the user stations (100) cannot input information for valuing the property. The examiner disagrees with this interpretation noting that Hough clearly states that "a remote user communicates with the system 10 is essentially the same as a remote user station communicates with a multiple listing database". It is well known that a user having access to a multiple listing database can input property related data for example, to list a property for sale. Therefore, the applicant's argument that only a single user station 100 can input the information for valuing the property is not persuasive.

#### ***Election/Restrictions***

4. Newly submitted claim 16 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

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Claim 16 recites a distinct and mutually exclusive species of the originally presented invention. The originally presented species of claims are directed to valuation of a real estate property. The instant claim recites a species, which pertains to financing of the real estate property.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 16 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 12-15 and 21-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claims 12-15 and 21-22 are not sufficiently precise due to the combining of two different statutory classes of invention in a single claim. The preamble the claim refers to a method, but the body of the claim discusses the specifics of the system (e.g. claim 12 recites “the plurality of client computer comprises”, claim 13 recites “the property management services server further comprises” etc.). Note that claim 15 recites limitation of a process whereas the parent claim 1 is a system claim.

Newly added claims 21 and 22 are similarly analyzed as being indefinite.

### ***Claim Rejections - 35 USC § 101***

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 12-15 and 21-22 are rejected under 35 U.S.C. §101 because the claimed invention is directed to a non-statutory subject matter.

35 U.S.C. §101 requires that in order to be patentable the invention must be a “new and useful process, machine, manufacture or composition of matter or new and useful improvement thereof” (emphasis added). Applicant’s claims mentioned above are intended to embrace or overlap two different statutory classes of invention as set forth in 35 U.S.C. §101. The claim begins by discussing a method (ex. Preamble of claim 12-15), the body of the claim discusses the specifics of the system (client computers, property management services server, property valuation tool) and method (explain method limitations). (see rejection of claims under 35 U.S.C. §112, second paragraph, for specific details regarding this issue). “a claim of this type is precluded by express language of 35 U.S.C. §101 which is drafted so as to set forth statutory the statutory classes of invention in the alternative only”, Ex parte Lyell (17USPQ2d 1548).

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Note that claim 15 recites limitation of a process whereas the parent claim 1 is a system claim.

Newly added claims 21 and 22 are similarly analyzed as being non-statutory.

***Double Patenting***

5. Claims 21 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 12 . When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claim 1-5, 15 and 17-20 are is rejected under 35 U.S.C. 102(b) as being anticipated by Hough (US 5414621) (hereafter Hough).

Per claim 1 Hough discloses a computer-implemented system for determining a valuation of a real estate property in an on-line computing environment, comprising (see Figure 1):

a property management server (comparative computation unit 14);

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a plurality of databases coupled to the property management services server via a distributed computer network;

(multiple listing computer database 18 are connected to comparative computation unit 14 via modem 19);

a plurality of client computers, each connected to the distributed computer network (remote user station 100 in multiple user network);

the property management services server hosting a valuation program module for calculating a valuation for a selected real estate property (see comparative computation unit 14 which implements the assessment analysis, selected property is "subject property" col. 4 and the valuation of a selected property is calculated as per step 58 shown in Figure 3);

the databases storing real estate property-related data, including property comparables data for a plurality of real estate properties, (see multiple listing computer database 18 which comprises property data and tax assessment data),

the client computers operable to access the valuation program module operating on the property management services server and to input predetermined information about the selected real estate property in support of a valuation calculation for the selected real estate property, (remote user stations 100, which are operable to access the system 10, each of the remote user stations 100 are operable to input information data via a keyboard 102 as explained at col. 9 L 66-col. 10 L6)

wherein, responsive to the predetermined information about the selected real estate property, the valuation program operating on the property management services server accesses the property data in at least one of the databases via the computer network to obtain comparables relevant to the selected real estate property, and presents the valuation and the comparables for the selected real estate property.

(refer to Figures 2-58).

Claim 2-3: wherein the client computers comprise:

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Client computer operable to evaluate ...; .. to support property financing requirements; .. to support on-site review; ..to property related expertise; to screen, negotiate and close...

(each of these limitations are treated as non-limiting elements because the claim merely recites intended use of the client computers in conjunction with associated intended functionality (such as ..to evaluate the selected real estate property for a potential purchase or lease).

Note that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See, e.g., In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997)

Claim 4: wherein the property management services server further comprises at least one program module for at least one property valuation tool.

(refer to comparative computation unit 14 which comprises assessment analysis process ..which calculations for comparative values ..see col. 5 L 12-20).

Claim 5: the at least one property valuation tool comprises at least one of :

A property valuation tool ..(see claim 4);

Claim 15: ..electronically transmitting a valuation report ..to a plurality of third parties via corresponding one of the client computers.



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(see col. 9 L 66 – col. 10 L 18)

All limitations of newly added system claims 17-20 have been analyzed as per claims 1-5.

11. Claims 5-10 and 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hough (US 5,414,621) (Hough) and further in view of Official Notice.

12. Per claims 5 and 6 Hough as applied to claim 4 fail to teach that the valuation tool comprises at least a payback calculation tool and the payback calculation tool further comprises at least a refinancing calculator operable to determine refinance loan savings and break even terms for a property loan related to the selected property.

Official Notice is taken that payback calculation tool comprising at least a refinancing calculator for financial analysis of a selected real estate property are old and well known.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate these tools in Hough it would assist a user in analysis of financial management of the real estate property which is being evaluated possibly for purchase or investment.

13. per claims 5 and 7 Hough as applied to claim 4 fail to teach that the valuation tool comprises at least a cash flow calculation tool and the cash flow calculation tool further comprises at least a mortgage and amortization calculator operable to determine refinance loan savings and break even terms for a property loan related to the selected property.

Official Notice is taken that cash flow calculation and mortgage and amortization calculator for financial analysis a selected real estate property are old and well known.

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It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate these tools in Hough it would assist a user in analysis of financial management of the real estate property which is being evaluated possibly for purchase or investment.

14. As per claims 8-10 and 21-22 Hough teach a computer-implemented method for calculating an estimate of the value of a property comprising the steps of:

entering property details into a program module operating on a server via a first one of a plurality of client computers operating in a distributing computing environment ;

(refer to claim 1 analysis)

obtaining comparable data for the property by accessing at least one database accessible in the distributing computing environment, each database storing comparables data for a plurality of properties (refer to Hough Fig. 2 step 26 ).

Entering capital expenses (step 29, home improvements and other factors), investment details (sale price and sale terms, see Fig. 1, FFBC and other special taxes, see col. 5 L 1+),

Determining a value for the property based on the property details and comparable data (see Fig.2 comparative values 28, property details 29, selling price 32);

Presenting a report indicating the value of the property (see col. 10 L 65 – col. 10 L 6).

Hough, however, fails to teach, the steps of entering capital expenses, mortgage details and investment details fails to teach that the determination of the value of the property is based on capital expenses and mortgage details.

Official Notice is taken that determination of asset prices (for example, of a commercial or industrial property) based upon capital expenses (such as improvements) and mortgage details (such as available terms of financing for the property) and investment details including a future value for the property (depreciation) and discount rate (special incentive offered by the seller) are old and well known.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the aforementioned features in the cited prior art to determine value for the property because the combined method is applicable to price determination which can be useful in wider range of applications such as commercial and industrial properties which numerous factors have significant impact on the value of the property.

Claim 9: regarding the elements of the mortgage detail for the property, it is asserted that payment for the property, a rate type for the property and the term for the property are old and well known in the art, and therefore incorporated in the officially taken notice.

Claim 10: regarding the elements of the investment detail for the property, it is asserted that price for the property, a future for the property and the discount rate for the property are old and well known in the art, and therefore incorporated in the officially taken notice.

Claim 11: ..electronically transmitting a valuation report ..to a plurality of third parties via corresponding one of the client computers.

(see col. 9 L 66 – col. 10 L 18)

Claim 12: refer to analysis of claim 2.

Claim 13: refer to analysis of claim 4.

Claim 14: refer to analysis of claim 5.

Claim 21 is a duplicate claim of dependent claim 12.

Claim 22: presenting a valuation report..see claim 1 anlysis.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

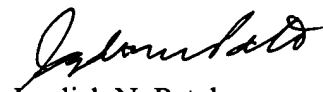
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (571) 272-6748. The examiner can normally be reached on 800AM-600PM M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 517-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jagdish N. Patel

(Primary Examiner, AU 3624)

9/30/05